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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,715	03/19/2002	Alex Roche	B-4537PCT 619589-5	7580
22879 7590 09/14/2007 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			EXAMINER ALLEN, WILLIAM J	
			ART UNIT 3625	PAPER NUMBER
			MAIL DATE 09/14/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/088,715

Applicant(s)

ROCHE, ALEX

Examiner

William J. Allen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2007.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 32 and 35-62 is/are pending in the application.  
4a) Of the above claim(s) 32 and 35-62 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Prosecution History Summary***

Claims 2-31 and 33-34 have been cancelled.

Claims 32 and 35-62 are hereby withdrawn by the Examiner as set forth below.

Claim 1 is rejected as set forth below.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/30/2007 has been entered.

*Election/Restrictions*

Newly submitted claims 32-43 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Group I, claims 1-15, drawn to a method of operating an online retailing operation for retailing of at least one print product to a customer, said print product supplied by a print merchant.

Group II, claims 32-49, 50-53, and 54-62, drawn to a method for automatic operation of an online print merchant, a method of operating a print service provider, and a method of operating a print merchant for matching a plurality of orders for print products.

The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Group II incorporates such special features as allowing a plurality of content retailers to offer a plurality of print products from a plurality of content providers to retail customers for print orders where the orders are fulfilled via a plurality of print providers each using print

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manager software, a plurality of printers, and a plurality of couriers to deliver the print products (see claim 32) not incorporated into Group I. Additionally, claim 50 recites receiving image content data and transferring said content to a printer device for printing, and claim 54 includes receiving a request for an order identification and issuing the order identification. For at least these reasons above, Group II constitutes a different inventive concept than that of the originally presented claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 32 and 35-62 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Response to Arguments***

Applicant's arguments filed 7/30/2007 have been considered but are moot in view of the new ground(s) of rejection. Applicant's amendment necessitated the new grounds of rejection.

Additionally, regarding Applicant's remarks on page 12 concerning claim 32, the Examiner notes that, as outlined above, claim 32 is still drawn to an invention that, if presented originally, would have been restrictable from the examined group.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**1. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle (US 6133985) in view of von Rosen (US 6493677) in further view of PTO form 892 reference U.**

**Regarding claims 1 and related claim 13, Garfinkle teaches:**

*displaying a plurality of image items for online viewing by said customer at a content retailer web site operated by or for a content retailer* (see at least: col. 2 line 64-col. 3 line 4, col. 3 lines 19-21 and 62-67, col. 4 lines 1-6 and 61-66, col. 5 lines 7-13, col. 7 lines 5-16 and 45-49).

The Examiner notes that the scanning center and image server are accessed through interface B and constitute a “content retailer”;

*transacting an order of a first type between said customer and said content retailer for supply of said at least one print product based on said customer ordering said at least one print product after viewing at least one of said image items at said content retailer* (see at least: col. 5 lines 7-13 and 25-34, col. 7 lines 5-16 and 45-49, Fig. 5→5A(note 5D)→5D→5E(note element 5o)); The Examiner notes that the user access the scanning center/image server through interface B to place and order, the order being stored on the server for transfer to the fulfillment center;

*transacting an order of a second type between said content retailer and said print merchant for fulfillment of said first type order by said print merchant* (see at least: col. 9 lines

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17-21 and 25-28, Fig. 5E (note #5o)); The Examiner notes that order placed through interface B are stored on the image server and transferred to the fulfillments center (i.e. print merchant).

Additionally, despite Garfinkle teaching where the fulfillment center “fulfills, charges, and delivers” an order (see at least: col. 3 lines 21-23), and further where the order may “be delivered by standard mail” (see at least: col. 9 lines 34-35), Garfinkle does not expressly teach *transacting an order of a third type between said print merchant and a print service provider for shipping said at one print product ordered by the customer pursuant to said first type order*.

In the same field of endeavor, von Rosen teaches a system allowing users to submit digital images, edit and customize those images, and have those images branded (i.e. printed) on merchandise labels (see at least: abstract). In addition, von Rosen further teaches *transacting an order of a third type between said print merchant and a print service provider for shipping said at one print product ordered by the customer pursuant to said first type order* (see at least: Fig. 10B and 13B, col. 5 lines 55-63). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Garfinkle to have included *transacting an order of a third type between said print merchant and a print service provider for shipping said at one print product ordered by the customer pursuant to said first type order* as taught by von Rosen in order to provide a system that for creating and ordering customized branded merchandise over a computer network that advantageously automates the production of the merchandise and the shipping of the merchandise to the customer upon confirmation of the order (see at least: von Rosen, col. 2 lines 1-12, Fig. 13B).

Furthermore, though Garfinkle teaches transacting orders of a first and second type with retail customers, Garfinkle does not explicitly teach *offering a direct service to business customers for generating print products from their own content*, nor does Garfinkle teach the fulfillment of *business customer* orders by the print merchant. The Examiner additionally notes that the practice of providing both retail service to general customers as well as business services to business customers is both old and well known in the art of providing printing services.

In the field of providing print services online, PTO 892 U teaches where a user can upload information such as a company logo to be incorporated in a print job such as a calendar (see at least: 892 U paragraphs 1 and 3). In this regard, it is clear that PTO 892 U teaches *offering a direct service to business customers for generating print products from their own content* and the fulfillment of *business customer* orders by the print merchant. Thereby, it would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Garfinkle to have included such features as taught by PTO 892 U because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.



*Conclusion*

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- PTO 892 V teaches Kinko's Liveprint online service for both retail and business customers
- PTO 892 W teaches the use of Liveprint online by business customers
- PTO 892 X teaches "Print to Kinko's", an online service that allows customers to up-load documents and have them printed worldwide
- PTO 892 Y teaches the launching of the "Print to Kinko's" service

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443.

The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen  
Patent Examiner  
September 10, 2007



Mark Fadok

Primary Examiner